REMARKS

Claims 1-26 are in this application. By this amendment, claims 9 and 11 have been amended. Re-examination, reconsideration and allowance of this application is respectfully requested. No new matter is added.

Dependent claim 9 has been amended to change "method" to <u>system</u> for agreement with the base claim 7. Claim 11 has been amended to change "said identifying indicia" to "<u>specific</u> identifying indicia" for proper antecedent basis. It is believed that these amendments do not involve narrowing limitations.

REJECTION UNDER 35 U.S.C. 103

Claims 1-26 were rejected under 35 U.S.C. 103 as being unpatentable over the Gabbard et al. reference in view of the Eggleston et al. reference. It was suggested that it would have been obvious to have incorporated recording the Internet Protocol header source address for each of the packets containing specific identifying indicia as taught by Eggleston et al. at col. 8, lines 22-63, in the method of Gabbard et al. to make the method more secure and reduce latency in processing the packets. These rejections are respectfully traversed as to Applicant's claims as amended.

The Applied References

The Eggleston et al. reference discloses a system for communicating user-selected criteria filter prepared at a wireless client to a communication server for filtering data transferred from a host to the wireless client. More particularly Eggleston et al. discloses five embodiments:

1. A system having virtual session manager (VSM) for establishing and maintaining a sessionless communication path with a first data processing device (e.g., a mobile client) and a session-oriented communication path with a second data processing device (e.g., a host system). The session-oriented communication protocol with the host system permits remote access to, e.g., LAN-based applications, while the virtual session, via a sessionless-oriented communication protocol, between the VSM and remote client (via a tariffed network or connection) for avoiding expense of a dedicated/circuit switched connection.

2. A prestage filter stage is provided for applying user-definable filter parameters (e.g., reject, pass or granularity filters) on data being transferred between the remote communication

unit and communication server. For downloading, e.g., email , a communication server controller preferably either forwards the filter parameters in a query object or message to the post office to apply and return qualified mail, or the communication server receives all unprocessed mail and applies the filters locally. For uploading, e.g., email from a client, a client controller applies an upload prestage filter so as to retain all filter rejected mail, while transmitting mail passing the filters.

3. A select and summary (S&S) listing or index is used to provide user flexibility in reviewing and requesting otherwise filtered data. Both the user's remote communication unit and communication server maintain a S&S index containing identifying (summary) information about data which has not been fully transferred between the communication unit and communication server. As new data is reviewed and filtered for transfer, identifying/summary information is captured for any non-qualifying data by either a host unit or the communication server. This information is stored in the communication server's S&S index, and at least periodically transferred via update messaging to the remote communication unit. Upon reviewing its updates or its S&S index, the user may send a request for such of the data that it desires partial or full transfers for further review.

4. A method and apparatus for optimized reply to messaging is provided. The remote communication unit's controller generates a delta (e.g., data representing the content difference between two messages) between a preceding message and the reply message, and forms an optimized reply using the delta and an identifier of the preceding messaging. The communication server reconstructs the full reply from the retrieved message and the delta, and forwards the full reply to the addressee. An optimized reply is similarly formed from a delta and identifying information of the preceding message, and sent to the remote unit for reducing volume and expense of reply messaging.

5. A rate governor for monitoring and controlling the amount of communications between the remote unit and communication server alerts a user to amounts (time and/or charges) spent or remaining, and once a use limit is reached further communication is restricted.

The Gabbard et al. reference discloses an advertisement system that enables a server to insert a tiled or watermarked image that references an advertisement behind the text of an e-mail message or posting.

Argument

The rejections under 35 U.S.C. 103 are believed to be inappropriate as to Applicant's claims as amended because each of the claims in this application requires one or more of the following that are not disclosed or suggested in any one or combination of the references:

1. The combination of examining file headers in file packets being transmitted over the Internet for specific identifying indicia and recording the IP header source address for each packet containing the indicia (independent claims 1, 11, 14, 17, and 22);

2. The above combination including recording the IP header destination address for the file (dependent claim 2 and independent claim 14);

3. The first combination including transmitting the identifying indicia and the source to a proprietor of the file (dependent claims 3 and 18);

4. The first combination wherein the examining includes searching the file headers for TCP headers having port numbers indicative of email messages, searching those packets for attachments, and locating the source Internet address in an IP header for files containing the attachments (dependent claims 5 and 12, independent claim 17);

5. The above combination wherein the searching for attachments includes searching for MIME headers indicative of attachments, and searching a directly prepended file header for the identifying indicia when the MIME header indicates an attachment having a sought file type (dependent claim 12, independent claim 17);

6. The first combination wherein the identifying indicia includes a prepended extension to an existing file format, an imbedded bit sequence, or absence of code in a predefined file area (dependent claims 6, 13, and 26);

7. A system including a server, a monitor, and either a router or a modem, wherein the monitor is programmed to perform the process of the first combination (independent claims 7, 10, and 20);

8. The above system wherein the monitor is further programmed according to the fourth combination (dependent claims 8 and 21); and

9. The above system wherein the identifying indicia includes a prepended extension to an existing file format, an imbedded bit sequence, or absence of code in a predefined file area (dependent claim 9).

The references fail to disclose or suggest Applicant's invention because the neither of the applied references, either alone or in combination, discloses or suggests Applicant's claimed method.

More importantly, the rejection is based on an improper combination in that neither of the applied references suggests a modification or improvement of the system disclosed in the other reference. The Eggleston et al. reference is directed to filtering transmissions for the purpose of limiting usage of expensive communication paths; the Gabbard et al. reference is directed to the completely different purpose of inserting background references as advertisements. Thus one having ordinary skill in the art would not be expected to combine the references.

Further, it is not seen that the Eggleston et al reference discloses or suggests at col. 8, lines 22-63, either recording the IP header source address for packets containing specific identifying indicia (claims 1-26) or recording the IP header destination address for the file (claims 2 and 14).

Thus, even if the references are combined, there is no prima facie case of obviousness not only because a combination of the references fails to provide Applicant's invention, but also because the references do not suggest the combination. As stated in *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), in reversing a rejection under 35 U.S.C. 103:

> We are persuaded that the Board erred in its conclusion of prima facie
> obviousness . . .. The mere fact that the prior art could be so modified
> (merely turning the prior art upside down) would not have made the
> modification obvious unless the prior art suggested the desirability of the
> modification. (citations) 221 USPQ at 1127.

Similarly, the CAFC has demonstrated in *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988), the importance of requiring evidence of reasons in the prior art for making a combination of references before finding a prima facie case of obviousness. In response to the solicitor's argument that a combination of the references was "well within the skill of an ordinary practitioner," the Court stated:

> The PTO has the burden under section 103 to establish a *prima facie* case
> of obviousness. [citation omitted] It can satisfy this burden only by
> showing some objective teaching in the prior art or that knowledge
> generally available to one of ordinary skill in the art that would lead that
> individual to combine the relevant teachings of the references. [citations

omitted] The Board points to nothing in the cited references, alone or in combination, suggesting or teaching Fine's invention.

. . . . The Board reiterated the Examiner's bald assertion that "substitution of one type of detector for another in the system of Eads would have been within the skill of the art," but neither of them offered any support for or explanation of this conclusion.

. . . .

Obviousness is tested by "what the combination teachings of the references would have suggested to those of ordinary skill in the art." [citation omitted] But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." [citation omitted] And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id*. Here, the prior art contains none.

. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

5 USPQ2d at 1598-1600.

The references, taken as a whole, do not suggest Applicant's combination because the Gabbard et al. reference teaches directly or indirectly inserting advertisements in transmitted messages or postings, which is contrary to the teachings of Eggleston et al. that are directed to filtering transmissions to reduce the usage of costly communications channels. Applicant's invention is directed to tracking particular digital transmissions to identify their source, which is unrelated to the purposes to which either of the applied references are directed.

The dependent claims 2-6, 8, 9, 12, 13, 15, 16, 18, 19, 21, and 23-26 are further believed to be allowable based on the subject matter of claims 1, 7, 11, 14, 17, 20, and 22 from which they depend and because they further limit allowable subject matter.

Accordingly, it is believed that the rejection of claims 1-26 under 35 U.S.C. 103 have been overcome by the amendment and remarks; allowance thereof is respectfully requested.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned **Version with markings to show changes made**.

In view of the above, it is believed that this application, including each of the claims 1-26, is in condition for allowance. Such allowance is respectfully requested. If for some reason the Examiner considers otherwise, it is respectfully requested that a telephone call be placed to the undersigned so that issuance of a patent can be expedited.

No fee is believed due in connection with this matter; however, the Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 19-2090.

Respectfully submitted,

SHELDON & MAK PC

Date: ___3/24/03___   By:___Robert J. Rose___

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims

Claims 9 and 11 have been amended as follows:

9. (Amended) The ~~method~~ <u>system</u> of claim 7, wherein said identifying indicia comprises a user-defined character sequence selected from the group consisting of:

 an extension to an existing file format, prepended to the file;

 a sequence of bits embedded in the file; and

 an absence of code in a predefined area within the file.

11. A method for tracking the transmission of a digital file over the Internet comprising the steps of:

 receiving packets constituting segments of the file in transit over the Internet;

 examining file headers in said packets to determine the presence of ~~said~~ <u>specific</u> identifying indicia therein; and

 recording, for each of the packets containing said identifying indicia, the source Internet address for the file.